

104TH CONGRESS
2D SESSION

S. 1540

To amend chapter 14 of title 35, United States Code, to preserve the full term of patents.

IN THE SENATE OF THE UNITED STATES

JANUARY 26, 1996

Mr. HATCH introduced the following bill; which was read twice and referred to the Committee on the Judiciary

A BILL

To amend chapter 14 of title 35, United States Code, to preserve the full term of patents.

1 *Be it enacted by the Senate and House of Representa-*
2 *tives of the United States of America in Congress assembled,*

3 **SECTION 1. SHORT TITLE.**

4 This Act may be cited as the “Full Patent Term
5 Preservation Act of 1996”.

6 **SEC. 2. PATENT TERM DETERMINATION AUTHORITY.**

7 (a) IN GENERAL.—Section 154(b) of title 35, United
8 States Code, is amended to read as follows:

9 “(b) DETERMINATION OF PATENT TERM.—

10 “(1) BASIS FOR PATENT TERM ADJUSTMENT.—

“(A) IN GENERAL.—Subject to paragraph (2), the term of a patent shall be adjusted to include the period of time for which the issue of the original patent was delayed due to—

“(i) a proceeding under section 135(a) of this title;

“(ii) the imposition of an order pursuant to section 181 of this title;

“(iii) appellate review by the Board of Patent Appeals and Interferences or by a Federal court where the patent was issued pursuant to a decision in the review reversing an adverse determination of patentability; or

“(iv) an unusual administrative delay by the Office in issuing the patent.

“(B) REGULATIONS.—The Commissioner shall prescribe regulations to govern the determination of the period of delay, including the particular circumstances determined to be an unusual administrative delay under subparagraph (A).

“(2) LIMITATIONS.—

“(A) MAXIMUM PERIOD OF ADJUSTMENT.—The total duration of all adjustments

1 of a patent term under this subsection shall not
2 exceed 10 years. No patent term may be ad-
3 justed by a period greater than the actual pe-
4 riod of time that the issue of a patent was de-
5 layed as determined by the Commissioner. To
6 the extent that periods of delay attributable to
7 grounds specified in paragraph (1) overlap, the
8 period of any adjustment granted under this
9 subsection shall not exceed the actual number
10 of days the issuance of the patent was delayed.

11 “(B) DUE DILIGENCE.—The period of ad-
12 justment of the term of a patent under this
13 subsection shall be reduced by a period equal to
14 the time during the processing or examination
15 of the application leading to the patent in which
16 the applicant did not act with due diligence to
17 conclude processing or examination of the appli-
18 cation. The Commissioner shall prescribe regu-
19 lations establishing the circumstances that con-
20 stitute a failure of an applicant to act with due
21 diligence to conclude processing or examination
22 of an application.

23 “(C) TERMINAL DISCLAIMER.—No patent,
24 the term of which has been disclaimed beyond
25 a specified date, may be adjusted under this

1 section beyond the expiration date specified in
2 the disclaimer.

3 “(3) NOTICE TO COMMISSIONER.—In a case in
4 which a patent term is adjusted under this sub-
5 section, the Commissioner shall determine the period
6 of any patent term adjustment available under this
7 section and shall include a copy of that determina-
8 tion with the final notice. The Commissioner shall
9 prescribe regulations establishing procedures for the
10 application for, and notification of, patent term ad-
11 justments granted by the Commissioner under this
12 subsection.

13 “(4) JUDICIAL REVIEW.—Any applicant dissat-
14 isfied with a determination by the Commissioner
15 under paragraph (3) may have remedy by civil ac-
16 tion in the United States Court of Federal Claims
17 if commenced within 60 days after the mailing of
18 the notice of allowance as the Commissioner ap-
19 points. The initiation of a civil action under this sec-
20 tion shall not delay the issuance of a patent.”.

21 (b) TECHNICAL CLARIFICATION.—Section 156(a) of
22 title 35, United States Code, is amended—

23 (1) in the matter preceding paragraph (1) by
24 inserting “, which shall include any patent term ad-

1 justment granted under section 154(b),” after “the
2 original expiration date of the patent”; and

3 (2) in paragraph (2) by inserting before the
4 semicolon “, except as provided under section
5 154(b)”.
6

6 **SEC. 3. EFFECTIVE DATE.**

7 The amendments made by section 2 shall take effect
8 on the date of the enactment of this Act and shall apply
9 to any application filed on or after June 8, 1995.

○